

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appeal Brief Transmittal

AF/2700
2700
\$

In re application of: Bates, *et al.*

Serial No.: 09/633,766

Filed on: 08/07/00

For: **SATELLITE RADIO RECEIVER THAT DISPLAYS INFORMATION REGARDING ONE OR MORE CHANNELS THAT ARE NOT CURRENTLY BEING LISTENED TO**

Mail Stop APPEAL BRIEF - PATENT
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RECEIVED

FEB 23 2004

Technology Center 2600


Sir:

Transmitted herewith for filing is an **Appeal Brief** in triplicate for the above-identified Application.

- ☒ Please deduct \$330.00 from Deposit Account No. 09-0465 for IBM Corporation to cover the fee under 37 C.F.R. §1.17(f) for the filing of the enclosed appeal brief. A duplicate copy of this sheet is enclosed.
- ☒ The Commissioner is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 09-0465 for IBM Corporation. A duplicate copy of this sheet is enclosed.
- ☒ Any additional filing fees required under 37 C.F.R. §1.16.
- ☒ Any patent application processing fees under 37 C.F.R. §1.17, including fees for extensions of time, if needed.

MARTIN & ASSOCIATES, L.L.C.
P.O. Box 548
Carthage, MO 64836-0548
(417) 358-4700
FAX (417) 358-5757

Respectfully submitted,

By 
Derek P. Martin
Reg. No. 36,595

I HEREBY CERTIFY THAT THE CORRESPONDENCE TO WHICH THIS STATEMENT IS AFFIXED IS BEING DEPOSITED WITH THE UNITED STATES POSTAL SERVICE, POSTAGE PAID, AS FIRST CLASS MAIL IN AN ENVELOPE ADDRESSED TO: MAIL STOP APPEAL BRIEF - PATENT, COMMISSIONER FOR PATENTS, P.O. BOX 1450, ALEXANDRIA, VA 22313-1450.

Date: February 17, 2004

By: 



#9
2/24/04

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Bates, et al. Docket No.: ROC920000073US1
Serial No.: 09/633,766 Group Art Unit: 2684
Filed: 08/07/00 Examiner: D AGOSTA, STEPHEN M.

For: SATELLITE RADIO RECEIVER THAT DISPLAYS INFORMATION REGARDING
ONE OR MORE CHANNELS THAT ARE NOT CURRENTLY BEING LISTENED TO

APPEAL BRIEF

Mail Stop APPEAL BRIEF - PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RECEIVED
FEB 23 2004
Technology Center 2600

Dear Sir/Madam:

This appeal is taken from the Examiner's final rejection, set forth in the Office
Action dated 09/17/03, of appellant's claims 1-22. Appellant's Notice of Appeal under
37 C.F.R. § 1.191 was mailed on 12/16/03.

REAL PARTY IN INTEREST

International Business Machines Corporation is the Real Party in Interest.

RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences for this patent application.

02/23/2004 MAHME1 00000033 090465 09633766

01 FC:1402 330.00 DA

STATUS OF CLAIMS

As filed, this case included claims 1-22. In the first office action dated 1/16/03, all claims were rejected. In response to the first office action, a Request for Reconsideration was filed on 04/16/03. In the final office action, claims 1, 6-7, 9, 12, 16-17 and 19 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,978,689 to Tuoriniemi *et al.* (hereinafter “Tuoriniemi”) in view of U.S. Patent No. 6,122,011 to Dias *et al.* (hereinafter “Dias”) and further in view of U.S. Patent No. 5,152,012 to Schwob. Claim 2 was rejected under 35 U.S.C. §103(a) as being unpatentable over Tuoriniemi and Dias in view of U.S. Patent No. 5,416,774 to Shigematsu *et al.* (hereinafter “Shigematsu”). Claims 3-4, 10-11, 13-14 and 20-21 were rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Tuoriniemi, Dias, Shigematsu, U.S. Patent No. 6,239,794 to Yuen *et al.* (hereinafter “Yuen”), U.S. Patent No. 6,530,083 to Liebenow, and U.S. Patent No. 6,199,076 to Logan *et al.* (hereinafter “Logan”). Claims 5 and 15 were rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Tuoriniemi, Dias, Shigematsu, Yuen, and U.S. Patent No. 6,177,931 to Alexander *et al.* (hereinafter “Alexander”). Claims 8, 18 and 22 were rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Tuoriniemi, Dias, Alexander and Logan. No claim was allowed. The claims remaining in the case are claims 1-22 as originally filed, all of which stand finally rejected.

STATUS OF AMENDMENTS

Appellant has not amended the claims. The claims at issue in this appeal are claims 1-22 as originally filed.

SUMMARY OF INVENTION

A satellite radio receiver includes a display that displays information regarding one or more channels that are not currently being listened to. For a music channel, this information may include the name of the artist, the song title, time left in the song, etc. For a news channel, this information may include the news currently being discussed, the name of the news program, the time remaining, etc. For a sports channel, this information may include the name of the channel, a description of the sporting event, the time remaining, etc. The preferred embodiments include different ways to select which channels are “favorites” and therefore displayed on the display. One way is to select one or more channels that are assigned to preset buttons on the radio receiver. Another way is to keep track of which channels are most frequently listened to, and to display information regarding those channels. The preferred embodiments extend to any and all mechanisms for displaying information regarding one or more channels that are not currently being listened to.

ISSUES

The following issues are presented for review on this Appeal:

1. **Whether claims 1, 6-7, 9, 12, 16-17 and 19 are unpatentable as obvious under 35 U.S.C. §103(a) in view of Tuoriniemi, Dias and Schwob**
2. **Whether claim 2 is unpatentable as obvious under 35 U.S.C. §103(a) in view of Tuoriniemi, Dias, Schwob and Shigematsu**
3. **Whether claims 3-4, 10-11, 13-14 and 20-21 are unpatentable as obvious under 35 U.S.C. §103(a) in view of Tuoriniemi, Dias, Schwob, Shigematsu, Yuen, Liebenow, and Logan**
4. **Whether claims 5 and 15 are unpatentable as obvious under 35 U.S.C. §103(a) in view of Tuoriniemi, Dias, Schwob, Shigematsu, Yuen, and Alexander**
5. **Whether claims 8, 18 and 22 are unpatentable as obvious under 35 U.S.C. §103(a) in view of Tuoriniemi, Dias, Schwob, Alexander and Logan**

GROUPING OF CLAIMS

Claims 1, 2, 6, 12 and 16 are grouped, and stand and fall together based on claim 1. Claims 3 and 13 are grouped, and stand and fall together based on claim 3. Claims 4 and 14 are grouped, and stand and fall together based on claim 4. Claims 5 and 15 are grouped, and stand and fall together based on claim 5. Claims 7 and 17 are grouped, and stand and fall together based on claim 7. Claims 8 and 18 are grouped, and stand and fall together based on claim 8. Claims 9 and 19 are grouped, and stand and fall together based on claim 9. Claims 10, 11 and 20 are grouped, and stand and fall together based on claim 10. It is appellant's intention that the patentability, *vel non*, of claims 21 and 22 be considered independently, as these claims do not stand or fall with any other claim. This grouping of claims is appropriate because each set of claims includes a unique combination of limitations not found in the other sets of claims, and because the claims that are not grouped with any other claim include a unique combination of limitations not found in any of the groups.

ARGUMENT

Issue 1: Whether claims 1, 6-7, 9, 12, 16-17 and 19 are unpatentable as obvious under 35 U.S.C. §103(a) in view of Tuoriniemi, Dias and Schwob

Claim 1

In the rejection of claim 1, the Examiner admits that Tuoriniemi and appellant's discussion of the prior art is silent on a display that displays information regarding at least one channel that is not selected wherein the displayed information is derived from the identifying information for the at least one channel that is not the selected channel. The Examiner then cites to the television channel map in Dias, cites to the radio broadcast receiver in Schwob, and states that it would have been obvious to one skilled in the art at the time of the invention to modify Tuoriniemi, such that the system displays at least one channel that is not selected, to provide means for a user to simultaneously listen to one station/song while viewing if there is another station/song they prefer to switch to.

Dias displays its channel map on a television. A television is a visual and audio medium. As such, it requires a screen to display the television images. Because a television inherently has a large display area on its screen, an online channel guide may be displayed on the same screen as discussed in Dias. A satellite radio receiver, in contrast, is a device for providing audio programming to a user. A display on known satellite radio receivers only provides information about the currently-selected channel. Displays on known satellite receivers have very limited display areas, as shown by FIG. 7 of Shigematsu. For this reason, it would not have been obvious to one of ordinary skill in the art to apply the principles of a TV channel guide in Dias to a satellite radio receiver, because satellite radio receivers typically have such a limited display area that display of the channel guide in Dias would be impossible.

It is useful to consider the state of the art in satellite television receivers, which typically provide a channel guide as taught in Dias. Appellant's attorney owns an EchoStar satellite television receiver for receiving satellite programming from DishNetwork. This satellite television receiver has a single green light emitting diode (LED) that indicates when the receiver is on. There is no display of any other information in the receiver. The only "display" is via a television coupled to the satellite television receiver. The combination of a satellite television receiver and an external television does not read on a display "within the satellite radio receiver", as expressly recited in the claims. Appellant respectfully asserts that Dias expressly teaches away from a display on the satellite television receiver because it would never be needed when a television is coupled to a satellite television receiver. The TV would always serve as the display. Because satellite TV is both visual and audio, the visual display (TV) will always be present, making any sort of display that provides channel information on the satellite TV receiver itself redundant and unnecessarily costly.

The Examiner's liberal application of the teachings of channel guides for TVs to a satellite radio receiver ignores the fundamental differences between the two. Televisions are visual devices that require a large, detailed display screen to display TV programs. Because the screen is already present to display TV programs, the screen may also be used to display programming information, such as the channel guide in Dias. A satellite radio receiver, in contrast, is an audio device that outputs a selected audio program. A limited display is generally provided to display information regarding the currently selected audio program. Because satellite radio is an audio medium, one skilled in the art would not be motivated to incorporate a relatively large display into a satellite radio receiver to display a channel guide as taught in Dias. Note that the channel guide in Dias displays many channels, while the display shown in FIG. 4 of appellant's disclosure shows the display of only three non-selected channels. This limited display of a few non-selected channels would not be obvious in light of the teachings of channel guides for TVs as taught by Dias.

The Examiner cites to Schwob because Schwob teaches a radio broadcast receiver that has a screen that is larger than normal and has the capacity/size to display many different pieces of information at the same time. The radio receiver in Schwob displays more information than many traditional radio receivers, including date, time, alarm, sleep mode, type of music, city, and state. Note, however, that the display in Schwob only deals with the currently-selected station. Nowhere does Schwob teach or suggest that non-selected channels could be displayed.

The core issue is whether it would have been obvious to one of ordinary skill in art to provide a display within a satellite radio receiver that displays information regarding at least one channel that is not the selected channel based on the teachings of a visual channel guide in Dias and the radio display in Schwob. Appellant readily admits that Schwob teaches a display for a radio receiver that includes information not found in many prior art displays. However, the information on the Schwob display has nothing whatsoever to do with the display of information regarding one or more channels that are not the selected channel. Dias teaches a channel guide for a satellite television receiver that is displayed on a display (TV) that is separate from the satellite television receiver. Because the display in Dias that is used to display the channel guide is a separate TV, there is no need for such a display in the satellite television receiver of Dias. For these reasons, the combination of Tuoriniemi, Dias and Schwob does not render obvious claim 1 under 35 U.S.C. §103(a).

The Examiner's position that one of ordinary skill in the art would apply the teachings relating to an online channel guide in Dias to display this channel guide on the radio display of Schwob has no support in any of the cited references, and has no support based on knowledge in the art. Would one of ordinary skill in the art be motivated to attach a TV to a radio receiver to display information? Would one of ordinary skill in the art be motivated to provide a screen on a radio receiver that allows watching a video? These two examples seem somewhat absurd, but show the folly in the Examiner's

rejections. One cannot simply mix and match the teachings relating to television and the teachings relating to radio, because these two media have substantially different characteristics. For these reasons, the Examiner's liberal combination of the teachings of television and radio is in error.

In the Response to Arguments section at p. 2 of the final office action, the Examiner stated under item (2):

Since Schwob has a larger screen and XM Radio transmits artist and song title, one skilled in the art would provide for displaying the artist and song title on Schwob's display.

Appellant agrees completely with this specific statement by the Examiner, that it would be obvious to display the artist and song title OF THE CURRENTLY-PLAYING SONG on the display. But this is not the main issue. Claim 1 recites the display of information regarding at least one channel that is NOT THE SELECTED CHANNEL. The Examiner's defense of his arguments thus ignores this fundamental issue in claim 1. The fact that it would be obvious to display artist and song title of the currently-playing song does not make it obvious to display artist and song title of at least one channel that is not the selected channel.

Another problem with the Examiner's rejection is that it does not address the last clause of claim 1, which states: "wherein the displayed information is derived from the identifying information for the at least one channel that is not the selected channel." The identifying information is referenced in lines 3 and 4 of claim 1, which states: "each digital satellite radio signal including a radio program and identifying information related to the radio program." The displayed information in claim 1 is thus derived from the identifying information that accompanies a radio program. The displayed TV guide in Dias is not derived from identifying information that accompanies each TV program, but is a separate TV guide that is derived from static programming information for all of the

channels, not from information that accompanies the channel broadcast. For this reason, the combination cited by the Examiner does not teach or suggest the display of information for a non-selected channel that is derived from the identifying information for the channel.

Appellant respectfully asserts that the Examiner's rationale for combining Tuoriniemi, Dias and Schwob is improper. The Examiner states:

It would have been obvious to one skilled in the art at the time of the invention to modify Tuoriniemi, such that the system displays at least one channel that is not selected, to provide means for a user to simultaneously listen to one station/song while viewing if there is another station/song they prefer to switch to.

If we strip away the specific language the Examiner uses, the Examiner's rationale basically states that it would be obvious to modify Tuoriniemi with the channel guide taught in Dias and the display taught in Schwob to provide the advantages of the claimed invention. This is not a proper rationale for combining Tuoriniemi, Dias and Schwob. If an Examiner could establish obviousness by stating that a combination of references A, B and C would be obvious because of advantages only taught in the claims, the Examiner's job would be very simple, indeed. Nowhere does Tuoriniemi, Dias, Schwob, nor their combination teach or suggest a display within a satellite radio receiver that displays information regarding at least one channel that is not the selected channel. There is no motivation in any of these references to support their combination. The only motivation resides in appellant's claims, which amounts to impermissible hindsight reconstruction. One skilled in the art looking at these three references would realize that a satellite radio receiver typically does not include a "screen" that is capable of displaying the online channel guide in Dias, and would therefore not be motivated to apply the teachings of Dias to Tuoriniemi and Schwob, as suggested by the Examiner. For these many reasons given above, appellant respectfully asserts that the Examiner's rejection of claim 1 is

improper, and respectfully requests that the Examiner's rejection of claim 1 under 35 U.S.C. §103(a) be reversed.

Claims 6, 12 and 16

Claims 6, 12 and 16 are grouped with claim 1, and stand or fall according to the allowability of claim 1.

Claim 7

The arguments above with respect to claim 1 apply equally to claim 7, and are incorporated in this section by reference. In the rejection, the Examiner reads the radiotext in Tuoriniemi on the limitations in claim 7. Note, however, that the radiotext in Tuoriniemi relates to the currently-selected channel, and Tuoriniemi does not explicitly teach the display of this radiotext. The "displayed information" in claim 7 relates to at least one channel that is not the selected channel, as expressly recited in claim 1. The existence of radiotext information for the currently-selected channel does not teach or suggest the display of radiotext information for non-selected channels. For this reason, claim 7 is allowable over the cited art. In addition, claim 7 depends on claim 1, which is allowable for the reasons given above. As a result, claim 7 is also allowable as depending on an allowable independent claim. Appellant respectfully requests that the Examiner's rejection of claim 7 under 35 U.S.C. §103(a) be reversed.

Claim 17

Claim 17 is grouped with claim 7, and stands or falls according to the allowability of claim 7.

Claim 9

The arguments above with respect to claim 1 apply equally to claim 9, and are incorporated in this section by reference. In the rejection, the Examiner reads the radiotext in Tuoriniemi on the limitations in claim 9. Note, however, that the radiotext in Tuoriniemi relates to the currently-selected channel, and Tuoriniemi does not explicitly teach the display of this radiotext. The “displayed information” in claim 9 relates to at least one channel that is not the selected channel, as expressly recited in claim 1. The existence of radiotext information for the currently-selected channel does not teach or suggest the display of radiotext information for non-selected channels. For this reason, claim 9 is allowable over the cited art. In addition, claim 9 depends on claim 1, which is allowable for the reasons given above. As a result, claim 9 is also allowable as depending on an allowable independent claim. Appellant respectfully requests that the Examiner’s rejection of claim 9 under 35 U.S.C. §103(a) be reversed.

Claim 19

Claim 19 is grouped with claim 9, and stands or falls according to the allowability of claim 9.

Issue 2: Whether claim 2 is unpatentable as obvious under 35 U.S.C. §103(a) in view of Tuoriniemi, Dias, Schwob and Shigematsu

Claim 2 is grouped with claim 1, and stands or falls according to the allowability of claim 1.

Issue 3: Whether claims 3-4, 10-11, 13-14 and 20-21 are unpatentable as obvious under 35 U.S.C. §103(a) in view of Tuoriniemi, Dias, Schwob, Shigematsu, Yuen, Liebenow, and Logan

Claim 3

The arguments above with respect to claim 1 apply equally to claim 3, and are incorporated in this section by reference. In the rejection, the Examiner states that Liebenow teaches a radio or television receiver where a user may specify a list of favorite channels or stations, and concludes that it would have been obvious based on the teachings of Liebenow to modify Tuoriniemi “such that the memory contains a favorites list, to provide means for the user to simultaneously listen to a radio program/song and view other program/songs available which may be among their favorites list.” Again, the Examiner’s rationale for combining Liebenow with Tuoriniemi is essentially so one would enjoy the benefits of the claimed invention. Neither Liebenow, Tuoriniemi, nor knowledge in the art teach or suggest the desirability of this combination absent the benefits outlined in the claims, which amounts to impermissible hindsight reconstruction. For this reason, the combination of Liebenow with Tuoriniemi is improper. In addition, claim 3 depends on claim 2, which depends on claim 1, which is allowable for the reasons given above. As a result, claim 3 is also allowable as depending on an allowable independent claim. For the many reasons given above, appellant respectfully requests that the Examiner’s rejection of claim 3 under 35 U.S.C. §103(a) be reversed.

Claim 13

Claim 13 is grouped with claim 3, and stands or falls according to the allowability of claim 3.

Claim 4

The arguments above with respect to claim 1 apply equally to claim 4, and are incorporated in this section by reference. In the rejection, the Examiner states that Yuen teaches that memory contains a favorite channel list that includes a list of channel identifiers, each channel identifier corresponding to one of a subset of the set of channels received by the tuner, citing the abstract of Yuen. The abstract of Yuen cited by the Examiner contains no reference to memory for storing favorite channels, and has no reference to channel identifiers. Yuen does teach in FIGS. 15 and 39 the display of channels according to the program that is currently playing on a channel. The filtered channel list of Yuen does not read on a list of favorite channels, as recited in claims 4 and 14. The channel guide for NBC will change from one category to another depending on the current program that is playing. For this reason, the filtered lists in Yuen do not read on the list of favorite channels recited in claims 4 and 14. Furthermore, the presets in claim 2 were supposedly disclosed in the radio of Shigematsu, while the favorite channels were supposedly disclosed in the TV listing in Yuen. How could the TV listings in Yuen be defined by a radio preset in Shigematsu? They clearly can't. While Liebenow teaches a list of favorite channels or stations, it has no teaching that the list of favorite channels or stations is at least partially defined by the at least one channel preset.

The Examiner has combined SEVEN references to allegedly read on the limitations in claims 4 and 14. Appellant readily admits that the sheer number of reference does not make a rejection in appropriate if there is sufficient suggestion in the references or in the art that supports the combination. However, in this case, NONE of these SEVEN references teach that a list of favorite channels is at least partially defined by one or more channel presets. This is a feature that is found ONLY in appellant's claims. The Examiner glosses over this fact, stating:

It would have been obvious to one skilled in the art at the time of the invention to modify Tuoriniemi, such that the list of favorite channels is at least partially defined by the at least one channel preset, to provide means for one channel preset to bring up a listing of favorites that can be associated with that preset (eg. several JAZZ stations can be viewed based upon selecting that one channel preset button).

Again, the Examiner has engaged in impermissible hindsight reconstruction by stating that one would be motivated based on the combination of these SEVEN references to arrive at a feature (list of favorites at least partially defined by one or more channel presets) that is only contained in the claims, and that is not present in ANY of the SEVEN references. For this reason, the Examiner has failed to establish a prima facie case of obviousness for claims 4 and 14 under 35 U.S.C. §103(a).

Appellant respectfully submits that a list of favorite channels that is at least partially defined by at least one channel preset, as recited in claims 4 and 14, patentably distinguishes over the combination of Tuoriniemi, Dias, Schwob, Shigematsu, Yuen, Liebenow and Logan. In addition, claim 4 depends on claim 3, which depends on claim 2, which depends on claim 1, which is allowable for the reasons given above. As a result, claim 4 is allowable as depending on an allowable independent claim. For the many reasons given above, appellant respectfully requests that the Examiner's rejection of claim 4 under 35 U.S.C. §103(a) be reversed.

Claim 14

Claim 14 is grouped with claim 4, and stands or falls according to the allowability of claim 4.

Claim 10

The arguments above with respect to claims 1, 3 and 6-9 apply equally to claim 10, and are incorporated in this section by reference. Claim 10 is a very detailed claim. The Examiner's attempt to combine SEVEN cited references to allegedly render obvious the detailed combination of features in claims 10 and 20 amounts to an attempt to pound a square peg into a round hole: it just doesn't fit. The Examiner has mixed and matched teachings of radio receivers with teachings of TV channel guides. As discussed above in detail with respect to claim 1, one of ordinary skill in the art would not be motivated to apply the teachings of a TV channel guide to a display in a radio receiver.

In the rejection, the Examiner reads the radiotext of Tuoriniemi as reading on the display of time remaining. First of all, the transmission of radiotext provides information to the receiver that could be displayed, but Tuoriniemi has no explicit teaching of displaying the radiotext. Furthermore, claims 10 and 20 include the limitation of displaying time remaining for the radio program corresponding to the selected channel, and displaying time remaining for the radio program corresponding to the at least one channel that is not the selected channel. The Examiner cites to Logan as allegedly teaching the display of time remaining for a radio program. Note, however, that the Logan system is an audio program and message distribution system in which a host system organizes and transmits program segments to client subscriber locations. The host organizes the program segments by subject matter and creates scheduled programming in accordance with preferences associated with each subscriber. The Logan system thus does not deal with real-time broadcasts, such as satellite radio broadcasts, but instead compiles programs and delivers the programs to the consumer at the consumer's scheduled time. For this reason, the indication of time remaining in a recorded message does not render obvious the display of time remaining for both the radio program corresponding to the selected channel and time remaining corresponding to the at least one channel that is not the selected channel. Even if Logan does read on displaying time

remaining for the selected channel, it would not be obvious in light of Logan to display time remaining for the non-selected channels. NONE of the SEVEN cited references nor their combination teach or suggest the display of time remaining for a selected radio program AND the display of time remaining for one or more non-selected radio programs. For this reason, claim 10 is allowable over the cited combination of Tuoriniemi, Dias, Schwob, Shigematsu, Yuen, Liebenow and Logan. Appellant respectfully requests that the Examiner's rejection of claim 10 under 35 U.S.C. §103(a) be reversed.

Claims 11 and 20

Claims 11 and 20 are grouped with claim 10, and stand or fall according to the allowability of claim 10.

Claim 21

The arguments above with respect to claims 1 and 4 apply equally to claim 21, and are incorporated in this section by reference. Claim 21 includes limitations similar to claim 4, which has been addressed in detail above, and additionally includes all of the limitations of claim 20 upon which it depends. Claim 21 is allowable for all of the reasons given above regarding the allowability of claim 4. In addition, claim 21 depends on claim 20, which is allowable for the reasons given above. As a result, claim 21 is also allowable as depending on an allowable independent claim. Appellant respectfully requests that the Examiner's rejection of claim 21 under 35 U.S.C. §103(a) be reversed.

Issue 4: Whether claims 5 and 15 are unpatentable as obvious under 35 U.S.C. §103(a) in view of Tuoriniemi, Dias, Schwob, Shigematsu, Yuen, and Alexander

Claim 5

The arguments above with respect to claim 1 apply equally to claim 5, and are incorporated in this section by reference. In the rejection, the Examiner states:

Alexander teaches a viewer profile which is based upon a person's viewing habits (eg. which shows they watch more frequently than others) and giving them a higher precedence over others in the viewing list AND/OR automatically tuning the TV to that show when it is on (C30, L45-67, see Nick at Night reference).

The Examiner then concludes that it would be obvious based on these teachings in Alexander to determine a list of favorites according to channels more frequently listened to. This logic forgets one very important point. Alexander does not decide which channels to include or exclude from a list based on which channels are watched more frequently than others. The only thing Alexander does is change the *position* of the channel in the list. Thus, more frequently watched channels could be placed higher on the list, while less frequently watched channels could be placed lower on the list. Nowhere does Alexander teach or suggest including frequently watched channels in a favorite list of channels that does not include all of the channels. For this reason, Alexander does not read on the determining a list of favorites according to which channels are listened to most frequently. For these reasons, appellant respectfully asserts that claim 5 is allowable over the combination of Tuoriniemi, Dias, Shigematsu, Yuen, and Alexander. In addition, claim 5 depends on claim 1, which is allowable for the reasons given above. As a result, claim 5 is also allowable as depending on an allowable independent claim. Appellant respectfully requests that the Examiner's rejection of claim 5 under 35 U.S.C. §103(a) be reversed.

Claim 15

Claim 15 is grouped with claim 5, and stands or falls according to the allowability of claim 5.

Issue 5: Whether claims 8, 18 and 22 are unpatentable as obvious under 35 U.S.C. §103(a) in view of Tuoriniemi, Dias, Schwob, Alexander and Logan

Claim 8

The arguments above with respect to claim 1 apply equally to claim 8, and are incorporated in this section by reference. In the rejection, the Examiner states: “Tuoriniemi teaches radiotext that identifies music, name of performer, change of program, etc., where the examiner interprets “etc.” to include time remaining.” How very convenient. Absent an express teaching in the cited art, the Examiner takes a simple expression “etc.” and reads that expression to include a feature that is only taught in the claims. This amounts to a **CLEAR** case of hindsight reconstruction. How would one skilled in the art be motivated to display time remaining based on the word “etc.” in Tuoriniemi? Such a position is borderline ludicrous. Appellant forcefully asserts that the word “etc.” cannot substitute for a positive recitation or suggestion of the limitation in the claim.

The Examiner cites Logan as teaching the display of time remaining in the currently playing segment. The Examiner then states:

It would have been obvious to one skilled in the art at the time of the invention to modify Tuoriniemi, such that the displayed information includes time remaining, to provide means for the user to decide - based

on time remaining - whether to keep listening to the station/song or to change the channel.

Again, the Examiner attempts to justify the combination of the two references based on advantages taught solely in the claims. Logan teaches the display of time remaining for a program. Note, however, that the “displayed information” in claim 8 refers to the “displayed information regarding at least one channel that is not the selected channel” in claim 1. Because Logan does not display time remaining for a non-selected channel, Logan cannot render obvious the limitations in claim 8, even when combined with the other cited references. The Examiner essentially states that it would be obvious based on Logan to provide means for the user to decide - based on time remaining - whether to keep listening to the station/song or to change the channel. However, the time remaining in claim 8 is time remaining for the displayed information, which corresponds to at least one non-selected channel in the claim. Thus, the Examiner’s rationale for rejecting claim 8 is defective. *Nowhere has the Examiner asserted that it would be obvious based on Logan to display time remaining for non-selected channels.* The Examiner’s rationale is based on allowing the user to decide based on time remaining for the selected station whether to keep listening to the station/song or to change the channel. This rationale does not address the limitation of displaying time remaining for radio programs on the non-selected channels. There is no teaching or suggestion in ANY of the cited references to support the display of time remaining for radio programs on non-selected channels. The only teaching of displaying time remaining for radio programs on non-selected channels is in the claims themselves. Hindsight reconstruction, pure and simple.

In the Response to Arguments section at p. 3 of the final office action, item (8), the Examiner states that applicant has mis-read the rejection. The Examiner then attempts to explain the rejection, but his explanation is not persuasive. The Examiner expressly states in the rejection “where the examiner interprets ‘etc.’ to include time remaining”. Regardless of the Examiner’s attempt to clarify, he cannot run away from his

express language, where the term “etc.” is used as justification of displaying something not taught in the reference.

Appellant forcefully asserts that the combination of Tuoriniemi, Dias, Schwob, Alexander, and Logan does not render obvious claim 8, and that claim 8 is therefore allowable over the cited art. In addition, claim 8 depends on claim 1, which is allowable for the reasons given above. As a result, claim 8 is also allowable as depending on an allowable independent claim. Appellant respectfully requests that the Examiner’s rejection of claim 8 under 35 U.S.C. §103(a) be reversed.

Claim 18

Claim 18 is grouped with claim 8, and stands or falls according to the allowability of claim 8.

Claim 22

The arguments above with respect to claims 1, 5 and 8 apply equally to claim 22, and are incorporated in this section by reference. The Examiner rejects claim 22 using language and rationale similar to the rejection of claims 5 and 15, addressed above. For the reasons given above with respect to claim 5, claim 22 is likewise allowable. In addition, claim 22 depends on claim 20, which is allowable for the reasons given above. As a result, claim 22 is also allowable as depending on an allowable independent claim. Appellant respectfully requests that the Examiner’s rejection of claim 22 under 35 U.S.C. §103(a) be reversed.

General Comments

All of the Examiner's rejections reek of hindsight reconstruction. The Federal Circuit has held:

To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher. In re Fine, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988)(quoting W.L. Gore & Assoc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 U.S.P.Q. 303, 312-13 (Fed. Cir. 1983)).

The Federal Circuit also held:

Care must be taken to avoid hindsight reconstruction by using "the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit." Grain Processing Corp. v. American Maize-Products Co., 840 F.2d 902, 907, 5 U.S.P.Q.2d 1788, 1792 (Fed. Cir. 1988)(quoting Orthopedic Equip. Co. v. United States, 702 F.2d 1005, 1012, 217 U.S.P.Q. 193, 199 (Fed. Cir. 1983)).

A detailed look at the rejections shows many features and combinations of features that are only disclosed in the claims, yet the Examiner has used the patent claims as a guide through the maze of prior art references, combining the references in a particular way so as to allegedly achieve the result of the claims. This amounts to impermissible hindsight reconstruction. This conclusion is bolstered by the fact that the Examiner has relied upon SEVEN different references in an attempt to show a combination for all of the limitation in appellant's claims. Appellant readily acknowledges that the sheer number of references does not make the rejection inappropriate if there is sufficient motivation in the art or in the references themselves to support the combination. However, in this case, the only motivation the Examiner has suggested for combining these references is the advantages that are only taught in the claims. In the two different Requests for

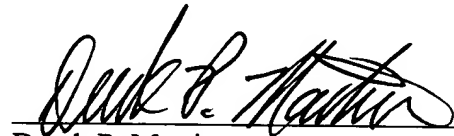
Reconsideration filed on 04/16/03 and on 08/08/03, appellant challenged the Examiner to provide rationale for combining the references that is based on teachings of the references or knowledge in the art, not based on the desirability of the claimed invention. Yet the Examiner has not met appellant's challenge. Nowhere do ANY of the references nor ANY knowledge in the art teach or suggest the desirability of combining features of a TV channel guide with a radio display to display information relating to a non-selected radio channel on the display of the radio receiver. We can draw a reasonable inference from the fact that the Examiner has not produced rationale for combining the references based on the references themselves or based on knowledge in the art that the combination is improper, because the only motivation cited by the Examiner is cited in appellant's claims. For this reason, the pending claims are clearly allowable over the cited art.

CONCLUSION

Claims 1-22 are addressed in this Appeal. For the numerous reasons articulated above, appellant maintains that the rejection of claims 1-22 under 35 U.S.C. § 103(a) is erroneous.

Appellant respectfully submits that this Appeal Brief fully responds to, and successfully contravenes, every ground of rejection and respectfully requests that the final rejection be reversed and that all claims in the subject patent application be found allowable.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Derek P. Martin", is written over a horizontal line.

Derek P. Martin
Reg. No. 36,595

MARTIN & ASSOCIATES, L.L.C.
P.O. Box 548
Carthage, MO 64836-0548
(417) 358-4700
Fax (417) 358-5757

APPENDIX - CLAIMS FINALLY REJECTED

- 1 1. (Original) A satellite radio receiver comprising:
2 a satellite radio processor that receives a plurality of digital satellite radio signals
3 on a plurality of channels, each digital satellite radio signal including a radio program and
4 identifying information related to the radio program, the satellite radio processor
5 outputting audio information corresponding to the radio program in one of the digital
6 satellite radio signals that correspond to a selected channel; and
7 a display within the satellite radio receiver that is coupled to the satellite radio
8 processor and that displays information regarding at least one channel that is not the
9 selected channel, wherein the displayed information is derived from the identifying
10 information for the at least one channel that is not the selected channel.
- 1 2. (Original) The satellite radio receiver of claim 1 further comprising a memory coupled
2 to the satellite radio processor, the memory containing at least one channel preset.
- 1 3. (Original) The satellite radio receiver of claim 2 wherein the memory further contains
2 a list of favorite channels, wherein the at least one channel that is not the selected channel
3 is in the list of favorite channels.
- 1 4. (Original) The satellite radio receiver of claim 3 wherein the list of favorite channels is
2 at least partially defined by the at least one channel preset.
- 1 5. (Original) The satellite radio receiver of claim 3 wherein the list of favorite channels is
2 determined by the satellite radio processor according to which channels are listened to
3 most frequently.

1 6. (Original) The satellite radio receiver of claim 1 wherein the display further displays
2 information regarding the selected channel, wherein the displayed information regarding
3 the selected channel is derived from the identifying information for the selected channel.

1 7. (Original) The satellite radio receiver of claim 1 wherein the displayed information
2 includes a title for the radio program.

1 8. (Original) The satellite radio receiver of claim 1 wherein the displayed information
2 includes time remaining for the radio program.

1 9. (Original) The satellite radio receiver of claim 1 wherein the displayed information
2 includes artist and song title for the radio program when the radio program comprises a
3 musical radio program.

1 10. (Original) A satellite radio receiver comprising:
2 (1) a satellite radio processor that receives a plurality of digital satellite radio
3 signals on a plurality of channels, each digital satellite radio signal including a radio
4 program and identifying information related to the radio program, the satellite radio
5 processor outputting audio information corresponding to the radio program in one of the
6 digital satellite radio signals that correspond to a selected channel;
7 (2) a display within the satellite radio receiver coupled to the satellite radio
8 processor that displays:
9 (2A) information regarding the selected channel, wherein the information
10 regarding the selected channel is derived from the identifying information for the
11 selected channel and includes a title for the radio program corresponding to the
12 selected channel and the time remaining for the radio program corresponding to
13 the selected channel; and
14 (2B) information regarding at least one channel that is not the selected
15 channel, wherein the information is derived from the identifying information for
16 the at least one channel that is not the selected channel and includes a title for the
17 radio program corresponding to the at least channel that is not the selected channel
18 and the time remaining for the radio program corresponding to the at least one
19 channel that is not the selected channel;
20 (3) a memory coupled to the satellite radio processor, the memory containing:
21 (3A) at least one channel preset; and
22 (3B) a list of favorite channels, wherein the at least one channel that is not
23 the selected channel is in the list of favorite channels.

1 11. (Original) The satellite radio receiver of claim 10 wherein the displayed information
2 includes artist and song title for the radio program when the radio program comprises a
3 musical radio program.

1 12. (Original) A method for displaying radio program information to a user on a display
2 within a satellite radio receiver, the method comprising the steps of:
3 receiving a plurality of digital satellite radio signals on a plurality of channels,
4 each digital satellite radio signal including a radio program and identifying information
5 related to the radio program;
6 outputting audio information corresponding to the radio program in one of the
7 digital satellite radio signals that correspond to a selected channel; and
8 displaying information regarding at least one channel that is not the selected
9 channel on the display, wherein the displayed information is derived from the identifying
10 information for the at least one channel that is not the selected channel.

1 13. (Original) The method of claim 12 further comprising the step of storing a list of
2 favorite channels, wherein the at least one channel that is not the selected channel is in
3 the list of favorite channels.

1 14. (Original) The method of claim 13 wherein the list of favorite channels is at least
2 partially defined by at least one channel preset.

1 15. (Original) The method of claim 13 further comprising the step of determining the list
2 of favorite channels according to which channels are listened to most frequently.

1 16. (Original) The method of claim 12 further comprising the step of displaying
2 information regarding the selected channel, wherein the displayed information regarding
3 the selected channel is derived from the identifying information for the selected channel.

1 17. (Original) The method of claim 12 wherein the displayed information includes a title
2 for the radio program.

1 18. (Original) The method of claim 12 wherein the displayed information includes time
2 remaining for the radio program.

1 19. (Original) The method of claim 12 wherein the displayed information includes artist
2 and song title for the radio program when the radio program comprises a musical radio
3 program.

1 20. (Original) A method for displaying radio program information to a user on a display
2 within a satellite radio receiver, the method comprising the steps of:
3 receiving a plurality of digital satellite radio signals on a plurality of channels,
4 each digital satellite radio signal including a radio program and identifying information
5 related to the radio program;
6 outputting audio information corresponding to the radio program in one of the
7 digital satellite radio signals that correspond to a selected channel;
8 displaying information regarding the selected channel on the display, wherein the
9 displayed information regarding the selected channel is derived from the identifying
10 information for the selected channel and includes a title for the radio program
11 corresponding to the selected channel and the time remaining for the radio program
12 corresponding to the selected channel;
13 displaying information regarding at least one channel that is not the selected
14 channel on the display, wherein the displayed information is derived from the identifying
15 information for the at least one channel that is not the selected channel and includes a title
16 for the radio program corresponding to the at least one channel that is not the selected
17 channel and the time remaining for the radio program corresponding to the at least one
18 channel that is not the selected channel; and
19 storing a list of favorite channels, wherein the at least one channel that is not the
20 selected channel is in the list of favorite channels.

1 21. (Original) The method of claim 20 wherein the list of favorite channels is at least
2 partially defined by at least one channel preset.

1 22. (Original) The method of claim 20 further comprising the step of determining the list
2 of favorite channels according to which channels are listened to most frequently.